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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/713,166 | 11/14/2003 | Matthias Von Samson-Himmelstjerna | 101769-233 | 9825 |

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NEW YORK, NY 10022

EXAMINER

MAKI, STEVEN D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1733

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/713,166 | VON SAMSON-HIMMELSTJERNA, MATTHIAS | |
| | Examiner | Art Unit | |
| | Steven D. Maki | 1733 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-20-06, 1-30-06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1) The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Incorporation of amended claim 2 into the specification. The description of the apparatus for unrolling in claim 2 was amended by changing "substrate" to --cable--. It is suggested to amend the description of the apparatus for unrolling in the specification in the same manner that claim 2 was amended.

2) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3) **Claims 1, 9-10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 (EP 1233046) in view of admitted prior art (page 2 lines 13-28) and Japan 535 (JP 2002-101535).**

Europe 046, the admitted prior art and Japan 535 are applied as in paragraph 4 of the last office action dated 10-6-05 (paragraph 4 of the last office action dated 10-6-05 is incorporated herein by reference).

Applicant argues that Europe 046 does not teach bringing a flat ribbon cable and a substrate together to bond the flat ribbon cable to the substrate. Applicant is incorrect. Europe 046 teaches bringing a flat cable and a substrate together and bonding the flat cable to the substrate. See paragraphs 1-4, paragraph 14 and claim 8 of the machine translation.

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Applicant argues that Europe 046 does not teach moving the flat ribbon cable and the substrate relative to one another. Applicant is incorrect. Europe 046's invention is the use of a release liner having double sided adhesive tape sections to bond parts together. Europe 046 teaches providing a hand held labeler with the release liner having double sided adhesive tape sections and using the hand held labeler to apply adhesive tape sections from the liner to the surface of one of the parts. After application of the double sided adhesive tape sections to one of the parts, the parts are bonded (glued / fastened) together. The step of bonding the parts together using double sided adhesive tape sections requires the step of moving one of the parts relative to the other part since if the double sided adhesive sections do not contact both parts, the parts cannot be bonded together as disclosed by Europe 046. With respect to parts to be bonded together using double sided adhesive tape sections, Europe 046 teaches that flat cable may be one of the parts. See paragraphs 1-4, paragraph 14 and claim 8 of the machine translation.

Applicant argues that Europe 046 does not teach a mount. More properly, Europe 046 and Japan 535 are both directed to bonding parts for an automobile. Furthermore, Europe 046 and Japan 535 teach bonding a flat cable to another part. Japan 535 suggests facilitating the bonding of a flat cable to a part (e.g. headlining of an automobile) by using a mount (setting member 1) for the flat cable. Japan 535 teaches that the benefit of using a mount to bond a flat cable to another part includes easy and correct positioning and mechanization of the bonding process. Motivated by the desire found in Europe 046 to bond a flat cable to a part for an automobile, one of ordinary skill

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in the art would have found it obvious to use a mount (setting member 1) to move the flat cable such that the flat cable and part for an automobile are assembled together and the double sided adhesive tape sections contact both the flat cable and the part for an automobile so as to bond the flat cable to the part as desired by Europe 046. The expected benefits of using such a mount / setting member 1 (instead of using manual assembly) include easy and correct positioning and mechanization of the bonding process as per the teachings of Japan 535.

Applicant argues that there is no suggestion in Europe 046 to apply the adhesive tape section to the flat ribbon cable. This argument is not persuasive. Europe 046 teaches using a hand held labeler to apply adhesive tape sections to one of the parts and using the adhesive tape sections to bond parts together. One of the parts may be a flat cable. When a flat cable is used, the adhesive tape sections must be applied to one of the parts. One of ordinary skill in the art would readily understand from Europe 046's broad teachings to use a flat cable as a part, apply adhesive tape sections to one part using a hand held labeler and then bond the parts together, that the adhesive tape sections can and should be applied to either of the parts to be bonded. More importantly, the admitted prior art, also directed to the automobile sector, suggests applying double sided adhesive tape to a flat cable when using the double sided adhesive tape to bond the flat cable to another part (the roof lining).

With respect to applying double sided adhesive tape to the flat cable, applicant argues that deficiencies of the cited art cannot be remedied by general conclusions about what is basic knowledge or common sense (page 9 last line nine lines).

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Applicant's argument is off-point since (1) the fact of bonding a flat cable to a substrate (another part) is documented on the record by Europe 046 and the admitted prior art and (2) the fact of applying double sided adhesive tape (albeit with release paper on one side) to a flat cable is documented on the record by the admitted prior art at page 2 lines 13-28 of specification.

Applicant argues and the examiner agrees that Japan 535 teaches applying adhesive to the substrate and not the flat cable. However, Europe 046 suggests applying the double sided adhesive tape in the form of double sided adhesive tape sections to either part and the admitted prior art specifically suggests applying double sided adhesive tape to the flat cable. Moreover, the use of Japan 535's mount (setting member 1) is applicable in Europe 046's process since (1) Europe 046 and Japan 535 both teach bonding a flat cable to another part and (2) movement of Japan 535's mount 1, which holds flat cable 4, toward head lining for an automobile is independent of the form of adhesive used (double sided adhesive tape or sprayed adhesive).

Applicant argues that Europe 046 does not teach that the grip of the mount on the flat cable is less than the adhesion between the substrate and the flat cable so that the cable is separated from the mount and remains bonded to the substrate when the mount is released. This argument is not persuasive for the simple reason that Japan 535 teaches moving clamps 2c after assembly of the flat cable and the other part (headliner for an automobile) so that the mount 1 can be detached from the flat cable and returned to its original location (paragraphs 5 and 12 of machine translation).

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4) Claims 2-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 in view of admitted prior art and Japan 535 as applied above and further in view of German 249 (DE 2617249) and optionally Hamisch (US 6138734).

German 249 and the optional Hamisch are applied as in paragraph 6 of the last office action dated 10-6-05 (paragraph 6 of the last office action dated 10-6-04 is incorporated herein by reference).

5) Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 in view of admitted prior art, Japan 535, German 249 and optionally Hamisch as applied above and further in view of Samuelson et al (US 5316613).

Samuelson et al is applied as in paragraph 7 of the last office action dated 10-6-05 (paragraph 7 of the last office action dated 10-6-04 is incorporated herein by reference).

6) Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 in view of admitted prior art, Japan 535, German 249 and optionally Hamisch as applied above and further in view of German 602 (DE 3834602).

German 602 is applied as in paragraph 8 of the last office action dated 10-6-05 (paragraph 8 of the last office action dated 10-6-04 is incorporated herein by reference).

7) Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Europe 046 in view of admitted prior art and Japan 535 as applied above and further in view of Barck (US 412630).

Barck is applied as in paragraph 9 of the last office action dated 10-6-05 (paragraph 9 of the last office action dated 10-6-04 is incorporated herein by reference).

Remarks

8) In view of the certified translations of the priority documents filed 3-20-06, applicant has perfected his priority to at least 8/1/03 and thereby removes US 2005/0056378 to Schwertfeger as a reference.

Applicant's arguments filed 1-30-06 have been fully considered but they are not persuasive.

9) No claim is allowed.

10) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

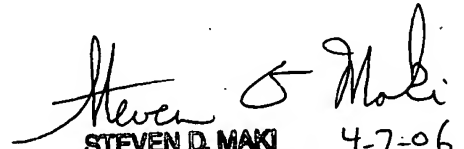
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki
April 7, 2006


STEVEN D. MAKI
PRIMARY EXAMINER 4-7-06